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Frank L. Jania

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EXAMINER

GOLDMAN, MICHAEL H

ART UNIT

PAPER NUMBER

3688

NOTIFICATION DATE

DELIVERY MODE

03/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/723,056	Applicant(s) JANIA, FRANK L.	
	Examiner MICHAEL H. GOLDMAN	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,11-15 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,11-15 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The following is a non-final action in response to communications received December 4, 2008. Claims 2, 3, 9, 10 and 16-17 have been previously cancelled. Therefore, claims 1, 4-8, 11-15, and 18-21 are pending and addressed below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Specifically, in independent claim 1, the preamble of the claim recites a system, indicating structure, means plus function or Hardware, whereas the body of the claim recites data structure or software per se, which is not statutory. Further 'storing selections, associated **with** the computer system...', 'evaluating said content...', 'performing an action on said content...' represent software, as disclosed in the specification, not means or Hardware. Additionally, the claim changes statutory class since the preamble talks about a system, while the body recites software per se, which renders the claims confusing under 35 U.S.C. 112(2).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claim 1 and the dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fails to meet the above requirements because the steps are neither tied to a particular machine or apparatus nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Also see, United State Court of Appeals for the Federal Circuit, 2007-1130,

(Serial No. 08/833,892)

IN RE BERNARD L. BILSKI

and RAND A. WARSAW.

For example in claim 1, the steps of “evaluating said content in view of the ...”, “performing an action on...” etc. should individually incorporate a particular machine (computer, apparatus or hardware per se); otherwise it can be concluded, under a broad interpretation, that those steps were manually performed. Here, to be statutory, under USC 101, each individual significant step should incorporate or should be performed using a particular machine (computer, apparatus or hardware per se) or at least one significant step should be performed using a particular machine.

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5. Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject.

Specifically, in independent claim 15, the preamble of the claim recites a system, indicating structure, means plus function or Hardware, whereas the body of the claim recites data structure or software per se, which is not statutory. Further, 'storing selections, associated **with** the computer system...', 'evaluating said content...', 'performing an action on said content...' represent software, as disclosed in the specification, not means or Hardware. Additionally, the claim changes statutory class since the preamble talks about a system, while the body recites software per se, which renders the claims confusing under 35 U.S.C. 112(2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1, 4-8, 11-15, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff et al. (20030158777) in view of Serena (6912571) and further in view of Katz et al. (7283974).

Claim 1, 8 and 15: Schiff et al. discloses a system, method and apparatus for filtering content presented on a computer, comprising:

storing selections associated with the computer, that *relate to each of a plurality of applications*, the selections including a priority level and at least one mode of presentment selected by a user via a user interface on the computer (see [0030], lines 1-3 whereby an Administration Server (AS) provided with *storage* means in which user portfolios are *stored*, also see [0025 and 0027], lines 5-7 where messages are displayed in a space of a web page and having user terminal to select the preferred form that can be viewed on a *graphical, textual or audio and/or video application, examiner construes graphical, textual or audio and/or video applications as a plurality of applications*, examiner further construes user terminal to select preferred form that can be viewed as at least one mode of presentment selected by a user via a user interface on the computer, also see [0028], lines 1-4 whereby in a preferred embodiment provides for the attachment (selection) of start and end dates before and after which the message cannot be displayed, control of when a message is displayed is construed by examiner as setting a priority level, also see [0026], line 3 a viewing priority for each Provider, also see [0064], lines 1-7 whereby the AS operates the system of the invention including *additional programs and*

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utilities, for example database of the content of providers, the billing system etc., examiner construes *additional programs and utilities as including a plurality of applications*);

indexing data relating to activities previously conducted on said computer system (see [0102], lines 1-3 whereby the AS give the user the option to see the history of his messages at user's terminal; examiner construes indexing as a file or directory on a server (definition from netlingo.com) and examiner construes user's terminal to be said computer);

storing indexed data and personal data in a database (see [0030], lines 1-3 where AS has means for storage and Fig 1B where AS is connected to databases such as Clients Data Base);

upon receiving content associated with activities on said computer via one of the applications, accessing said indexed data from database ((see [0017], lines 1-3 whereby AS in which portfolios are stored, said AS being in communication with a terminal belonging to a user; also where the AS has access to the databases, Fig 1B, examiner construes terminal user terminal in communication with AS, as said computer via one of the applications accessing said indexed data from said database);

accessing said selections relating to said application, priority level, and said at least one mode of presentment (see [0025 and 0027], lines 5-7 where messages are displayed in a space of a web page and having user terminal to select (access) the preferred form that can be viewed on a graphical, textual or audio and/or video *application*, examiner construes the preferred form that can be viewed as selecting at least one mode of presentment, also see [0028], lines 1-4 whereby in a preferred

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embodiment provides for the attachment (selection) of start and end dates before and after which the message cannot be displayed, control of when a message is displayed is construed by examiner as setting a priority level); [also see [0026], line 3 a viewing priority for each Provider];

comparing said content with said selections and the indexed data, resulting in a relevance determination (see [0064] lines 1-6 whereby the server operates the system which contains data relative to all the users' portfolio, and additional program and utilities, for example, the interfaces that enable the user to edit his portfolio, a database of the content et al, examiner construes programs and utilities that enable the user to edit his portfolio (content with said selections) and edit database of the content (indexed data) as resulting in a relevance determination, also see [0019], lines 1-3 whereby (the system) displays to one or more users on their terminal, messages according to the information contained in the user portfolio, examiner construes this matching of portfolio information and messages for viewing as resulting in a relevance determination);

performing an action on said content in accordance with said relevance determination and said selections (see [0022] lines 1-2 whereby an action performed is debiting the Provider for messages displayed to said one or more users).

applications including a messaging application and a web browser (a web page (see Fig 2A, a web page, and see Fig 2C, 'e-mail' under Message);

an interface profile system executing on said computer system, said interface profile system including an index logic component and an evaluation logic component

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(see [0018], lines 1-4 whereby every user generates and updates a user portfolio containing information relative to Providers and/or individuals the messages of which the user is willing to view; examiner construes this portfolio information as the index logic component; see [0019], lines 1-3 whereby (the system) displays to one or more users on their terminal, messages according to the information (index logic component) contained in the user portfolio, examiner construes this matching of portfolio information and messages for viewing as the evaluation logic component).

However Schiff et al. fails to explicitly disclose wherein the applications include a word processing application.

Serena discloses wherein the monitoring content in a database manager comprises a word processor (see column 13, lines 1-4).

Both Schiff et al. and Serena disclose computer implemented methods of controlling content in an application program or content exchanged between the application and an operating system. Therefore, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the invention of Schiff et al. to include an application including a word processor as taught by Serena in order to provide for a comprehensive method, system and storage medium for filtering content on a computer system.

However Schiff et al. and Serena fail to disclose the feature whereby evaluating content in view of the selections and the indexed data, to determine relevance of the content.

Katz et al. disclose the feature whereby evaluating content in view of the selections and the indexed data, to determine relevance of the content (see abstract, lines 10-19 whereby the system to effect a primary transaction, second obtaining data with respect to the primary

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transaction, including at least in part a determination of the identity of the user, third obtaining at least a second data element relating to the user, fourth, utilizing the primary transaction data along with the second data element as factors in determining (relevance for) at least one good, serviced or item of information for the prospective user/customer (in real-time), examiner construes second data element relating to the user as indexed data, also see Fig 5, item 204, database demographics and Fig 6, item 338 prior purchase database).

Both Schiff et al. and Serena, and Katz et al. disclose a system and method for electronic commerce via a network. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the invention of Schiff et al. to include the feature of evaluating content in view of the selections and the indexed data, to determine relevance of the content as taught by Katz et al. in order to improve the relevance of content/offers thereby increasing expected revenue from transactions.

Claim 4, 11 and 18: Schiff et al., Serena and Katz et al. disclose the invention as in claims 1, 8 and 15 above. Schiff et al. further discloses wherein said content includes at least one of:

a web page (see Fig 2A);

an advertisement (see Fig 2A);

an email (see Fig 2C, 'e-mail' under Message);

an instant message (see [0116], lines 1-4 citing FIG 6 with 3 examples of messages, construed by examiner as 'instant messages'); and a

a document (see [0156], line 11 it might also contain an XML file).

Claim 5, 12 and 19: Schiff et al., Serena and Katz et al. disclose the invention as in claim 1, 8 and 15 above. Schiff et al. further discloses a system wherein said at least one mode of presentment includes at least one of:

blocking said content (see [0166], line 8 Block Sender);

deleting said content (see [0166], line 9 Delete Company);

sending said content to a background screen of said computer system (see [0051], lines 1-2d whereby in one embodiment the RCMS may decode the pre-received *layout definition*, *construed by examiner to include background screen*, in order to automate the dynamic insertion of the related information);

storing said content (see claim 38, content can be forwarded anywhere in the network and in conjunction with storage means in the AS, storage of content is possible).

Claim 6, 13 and 20: Schiff et al., Serena and Katz et al. disclose the invention as in claims 1, 8 and 15 above. Schiff et al. further discloses a system wherein said at least one mode of presentment includes at least one of:

changing an appearance (see [0119], lines 10-12 wherein the AS will change the messages appearance according to the portfolio of the person surfing the computer);

sending an audio signal to said user at said computer system (see [0078] via a cellular as type of communication); and

flashing a notification of an incoming message on said computer screen (see Fig 9 item 91 whereby instant messages appear, examiner construes real time changes to satisfy flashing specification).

Claim 7, 14 and 21: Schiff et al., Serena and Katz et al. disclose the invention as in claims 6, 13 and 20 above. Schiff et al. further discloses a system wherein said *changing an appearance of said content includes at least one of:*

a color, a font, a texture and a highlight (see [0114] via banner editor, video editor software and 3D animation editor; also see Fig 6A-6C for different font, color and highlight).

Response to Arguments

8. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues for Claim 1 "...Schiff is devoid of teaching selecting a priority level that relates to applications...Rather, Schiff provides for the attachment of start and end dates before and after which a message cannot be displayed...Schiff generally discloses viewing priorities of applications, but does not provide any disclosure of how the viewing priorities are implemented. Accordingly, Schiff fails to teach or suggest 'storing selections' associated with the computer, that relate to each of a plurality of applications, the selections including a priority level,". Examiner respectfully disagrees as follows:

-Schiff, see [0028], whereby the attachment of start and end dates is a preferred embodiment, in another preferred embodiment, see [0026], whereby 'the information contained in the user's portfolio comprises an indication of a viewing priority for each Provider', examiner interprets each Provider as providing information via a variety of applications. Per applicants specification, [0013] 'The interface profile system enables email messages, web advertisements, and similar materials derived from a variety of applications to be filtered based upon priorities established by a user of the system. '

Examiner further interprets "user's portfolio" inherently having stored preference for each Provider, and each Provider may provide information via a variety (plurality) of applications.

Applicant further argues for Claim 1 "...According to Schiff, the 'additional programs and utilities; are contained on the server. The 'additional programs and utilities; are not associated with the user or the user portfolio...The portfolio contains information related to providers, messages and priorities but does not disclose any settings for applications, nor are there any provisions for application settings anywhere in Schiff". Examiner respectfully disagrees as follows:

-applicant claim element with respect to application setting reads as follows "storing selection, associated with the computer, that relate to each of a plurality of applications..."; see Schiff [0027], lines 5-9 whereby the advertisement should preferably be in a form that can be viewed on a graphical, textual, or audio and/or video application which enables to view messages on the Internet...", therefore Schiff addresses a plurality of applications from Providers. Examiner interprets Schiff user

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selection and storing of priorities for a Provider as implicitly providing a priority for the application. Examiner further interprets applicant claim for explicitly setting priorities for each application in addition to the Provider priority as an obvious variant with predictable results, and such 'application priority' for which applicant fails to explicitly specify a benefit or problem to be solved. Per applications specification [0013]

"The interface profile system enables email messages, web advertisements, and similar materials derived from a variety of applications to be filtered based upon priorities established by a user of the system. As used herein, the process of filtering content refers to examining any content received or accessed by a computer user (e.g., messages, documents, web pages, multi-media, etc.) and determining which content items are relevant by comparing them to previous activities conducted by a user and performing analysis on the data. "

The object of filtering the various applications is to derive the desired **content** which is the problem that is solved by Schiff et al. Examiner considers optimizing for applications as sub-optimization. The applicant specification does not address the benefits of sub-optimization of 'application' priorities, i.e. what problem is being solved?

Applicant further argues for Claim 1 "...Schiff fails to teach or suggest 'indexing data relating to activities previously conducted on said computer.'

Examiner respectfully disagrees, see Schiff et al. paragraph [0005] and [0006] which discloses that 'prior art, e.g. U.S. Patent 5933811, whereby system that follow the surfer (user) learn his interests by acquiring data on the web-sites visited, and deduce therefrom potential user preferences...has resulted in only a slight improvement, if any...This assumption has, so far, not produced sufficiently improved results. None of the prior art methods has provided a method by which the user is the one who requests messages from specific vendors to be shown to him, which is an aim of the (Schiff)

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invention, as opposed to the methods described above in which the system decides what and when to show to him.” Schiff solves the same problem as in the instant application and further teaches that from 'indexing data relating to activities previously conducted on said computer' since these methods fail to provide improved results as to deciding what and when to show to users.'

Applicant further argues for Claim 1 “...debiting is an action, it is not made in regard to 'relevance determination and said selections; but rather is based simply on taking money from a provider for every piece of content that is displayed to the user. There is no determination of relevance in the way the action is taken. Accordingly, Schiff may not be relied upon for teaching or suggesting, 'performing an action on said content in accordance with said relevance determination and said selections.”

Examiner respectfully disagrees as follows:

The instant application specification recites paragraph [0025]

, the interface profile system 114 performs an action on the content in accordance with the user's preferences and associated relevance factors at step 312.

Step 312 on Figure 3 'perform action on advertisement in accordance with user's priority level settings'

Also note paragraph [0027]

The interface profile system of the invention minimizes the burden of sifting through large quantities of messages, advertisements, and similar content and evaluates the relevance of the various content items on behalf of the user, and presenting or blocking the items in a manner consistent with the user's interests.

Examiner interprets action performed is that of presenting or blocking the items in a manner consistent with the user's interests, as explicitly provided in the rejection of Claim 1 above.

Conclusion

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg
March 5, 2009

/Jean Janvier/
Primary Examiner, Art Unit 3688